

Remarks/Arguments:

I. Status

The Office Action dated December 28, 2005 (the “Office Action”) has been carefully reviewed. Claims 21-27 have been added. Accordingly, claims 1-27 are pending in this application. Reconsideration of this application, as amended, is respectfully requested.

II. The Rejection of Claims 1, 2, 4 and 8 under 102(e)

In the Office Action, claims 1, 2, 4 and 8 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,598,791 B2 to Bellis, Jr. et al. (hereinafter “Bellis”). As verified by the Board of Patent Appeals and Interferences, Bellis does not disclose each element of claim 1.

Discussion Regarding the Patentability of Claim 1

1. Claim 1

Claim 1 recites:

A method of operating a self-service checkout terminal comprising the steps of:
allowing consumer scanning of an item for purchase via a scanner;
determining, after successfully scanning the item, whether the item has an active electronic article surveillance tag; and
allowing deactivation of the active electronic article surveillance tag by the consumer via an active electronic article surveillance tag deactivator after determining that the item has an electronic article surveillance tag

Thus, claim 1 recites a method in which a self-service checkout terminal is controlled such that a customer is allowed to deactivate an electronic article surveillance (EAS) tag after an item has been “successfully” scanned and it has been determined that the successfully scanned item includes an active EAS tag.

2. Bellis Does Not Disclose Deactivation Based Upon Detection

The Examiner has alleged that Bellis teaches the steps of “determining, after successfully scanning the item, whether the item has an active electronic article surveillance tag” and then allowing the deactivation of the scanned item. In support of this allegation, the Examiner cites to Bellis at column 9, lines 12-24. Bellis specifically states, however, that “[i]f an item was not properly scanned, the tag remains on the item and is sensed by the electronic article surveillance monitor 300.” (Bellis at column 9, lines 19-21). Consequently, if a tag is detected by the system of Bellis, the tag has not been successfully scanned and the customer is directed to “rescan the item.” (Bellis at column 9, lines 19-23). In contrast, the claim recites that the item has already been “successfully scanned.” An item that “was not properly scanned” is the antithesis of an item that was “successfully scanned” as claimed.

Therefore, Bellis does not disclose “determining, after successfully scanning the item, whether the item has an active electronic article surveillance tag” and then allowing the deactivation of the scanned item. Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Accordingly, because claim 1 recites steps of “determining, after successfully scanning the item, whether the item has an active electronic article surveillance tag” and then allowing the

deactivation of the scanned item and Bellis does not disclose any such method, the Applicants submit that the rejection of claim 1 should be withdrawn.

3. The BPAI Agrees With the Applicants

Additionally, the Board of Patent Appeals and Interferences (BPAI) has already considered the disclosure of Bellis and determined that Bellis does not disclose each element of claim 1. Specifically, U.S. Patent Publication No. 2002/0096564 (hereinafter the “‘564 publication”) was previously relied upon by the Examiner in rejecting the Applicants’ claims and is identified as prior art considered by the BPAI at page 2 of the decision regarding the present application dated November 30, 2005 (hereinafter “the BPAI Decision”). The ‘564 publication was published on July 25, 2002 and thereafter issued as U.S. Patent No. 6,598,791 B2 to Bellis, Jr. et al. on July 29, 2003. Thus, contrary to the Examiner’s assertion that Bellis is a “newly cited reference” (Office Action at page 2), Bellis is merely the issued patent of the reference that was previously relied upon by the Examiner.

The BPAI determined that “all of the claimed limitations are not taught or suggested by the applied prior art references.” (BPAI Decision at page 7). Thus, in looking for the limitations of the Applicants’ independent claims in the prior art, the BPAI has already considered and dismissed not only the teaching of Bellis, but also the teaching of Bellis in combination with the other references previously considered by the Examiner.

4. Conclusion

Therefore, because anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim and because the BPAI has already confirmed the Applicants' position that Bellis does not disclose all of the steps of claim 1, the Applicants respectfully submit that the rejection of claim 1 should be withdrawn.

Discussion Regarding the Patentability of Claims 2, 4 and 8

Claims 2, 4 and 8 also stand rejected as allegedly being anticipated by Bellis. Claims 2 and 4 depend directly from and incorporate all of the limitations of claim 1. Claim 8 is an independent claim which recites "an electronic article surveillance deactivator operative to deactivate the active electronic article surveillance tag after determining by the electronic article surveillance detector that a scanned item has the active electronic article surveillance tag" and which was also considered by the BPAI. Accordingly, for at least the same reasons as those set forth above in connection with claim 1, it is respectfully submitted that claims 2, 4 and 8 are patentable over the prior art.

III. The Rejection of Claims 1-20 under 103(a)

In the Office Action, claims 1-12 and 15-19 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent no. 6,857,567 B2 to Latimer et al. (hereinafter "Latimer") in view of Bellis and claims 13-14 and 20 were rejected under 35 U.S.C. 103(a) as being obvious over Latimer and Bellis in view of U.S. Patent no. 6,486,780 to Garber et al. (hereinafter "Garber"). The Applicants respectfully traverse.

Discussion Regarding the Patentability of Claim 1

1. Claim 1

As set forth above, claim 1 recites a method in which a self-service checkout terminal is controlled such that a customer is allowed to deactivate an electronic article surveillance (EAS) tag after an item has been “successfully” scanned and it has been determined that the successfully scanned item includes an active EAS tag

2. There is No Motivation to Modify Latimer

The Examiner rejected claim 1 based upon the proposition that Latimer disclosed all of the steps of claim 1 with the exception of the steps being used in a self-checkout system. (Office action at page 6). The Examiner relied upon Bellis for teaching a self-checkout system. Respectfully, there is no motivation for the proposed modification.

Specifically, the Examiner appears to have alleged that the proposed modification would “enhance the security system of Latimer.” (Office Action at page 6). The Examiner has failed to identify, however, any security needs in the system of Latimer. Latimer discloses “a PC-based training device that receives the information from the data reader for the purpose of training the operator.” (Latimer at column 1, lines 38-43). The system is thus designed to allow “for later analysis and reporting.” (Latimer at Abstract). Additionally, “[t]he system provides feedback to the operator indicating the effectiveness of the operator’s scanning technique.” (Latimer at column 1, lines 52-54). Thus, the system of Latimer is a training system for use in training operators to use an efficient

scanning technique. The Examiner has failed to explain how security against a customer absconding with merchandise is pertinent to the training of a scanning technique.

Moreover, this “motivation” appears to be the same motivation the Examiner has previously proposed and which the BPAI rejected with respect to modification of other prior art. (BPAI Decision at page 6). Like the previous modification, there is no need to modify Latimer, even assuming *arguendo* that the system is used at a point of sale, since detectors located at the exits of the store are fully capable of detecting EAS tags which have not been deactivated.

As the BPAI stated in the BPAI Decision, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (BPAI Decision at page 5, citing to *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Accordingly, because there is no teaching or suggestion to one skilled in the art to modify Latimer with Bellis, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claim 1. Accordingly, the Examiner is respectfully requested to withdraw this rejection of claim 1.

3. The Examiner’s Line of Reasoning is Not Convincing

The Examiner further alleged that the motivation for changing the system of Latimer to a self-checkout system was to “reduce time and labor” because “the operator/customer does not have to pass the scanned items back across the EAS sensing antenna to determine how many item (sic) are still active.” (Office Action at page 6). Respectfully, the Examiner’s reasoning is not clear.

As noted above, Latimer is directed to a training system for a terminal whereat employees, not customers, are scanning items. Therefore, there is no need to save the customer the inconvenience of passing scanned items back across the EAS sensing antenna to determine how many items are still active unless one first modifies Latimer to be a customer training system. Thus, the reasoning proposed by the Examiner is that some problems created by changing the system of Latimer may be mitigated thereby motivating one of skill in the art to make the modification. The “benefits” are thus illusory as they do not provide a motivation to *make* a change. Rather, the Examiner has merely alleged additional modification which may mitigate some of the problems caused by the proposed modification.

Likewise, reducing labor and time spent in training a store’s employees may provide a reason to change from an employee operated system to a self-checkout system. This benefit, however, does not lead to a modification of a training system, it leads to the elimination of the training system for employee operated terminals and replacement of employee operated terminals with self service terminals. Similarly, a modification to the training system of Latimer may in fact reduce training expenses. These benefits, however, are totally unrelated to a change from an employee training system to self service terminals.

Therefore, the line of reasoning proposed by the Examiner does not make sense. Accordingly, the reasoning is not convincing. Because the Examiner has failed to provide a convincing line of reasoning as required by MPEP § 2144, citing to *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985), the Examiner has failed to provide a

prima facie case of obviousness and the Examiner is respectfully requested to withdraw this rejection of claim 1.

4. Counting Tags for Training Does Not Deactivate the Tags

Moreover, the Examiner relied upon Latimer for disclosing the step of “allowing deactivation of the active electronic article surveillance tag by the consumer via an active electronic article surveillance tag deactivator after determining that the item has an electronic article surveillance tag.” (Office action at page 5). Respectfully, the Examiner has mischaracterized Latimer.

Specifically, the Examiner cited to Latimer at column 4, lines 8-16 for disclosing this step. (Office Action at page 5). At the cited passage, Latimer does disclose the use of an EAS antenna to determine whether or not an EAS tag had been deactivated. More precisely, Latimer states that “after a training run, an operator may pass the scanned items back across the EAS sensing antenna to determine how many items are still active.” (Latimer at column 4, lines 27-29). Detecting the number of unsuccessfully deactivated tags during a training exercise is not the same as allowing tags to be deactivated by a customer during a purchase. In fact, since the object of Latimer is training, there is no need to subsequently deactivate the EAS tag because there is no training objective served by such an action. The only basis for such a modification would be an attempt to arrive at the Applicants’ invention based upon the Applicants’ disclosure.

Thus, Latimer fails to disclose the step of allowing deactivation of the active electronic article surveillance tag by the consumer via an active electronic article surveillance tag deactivator after determining that the item has an electronic article

surveillance tag. Accordingly, even if Latimer is modified as suggested by the Examiner, the modification fails to arrive at the invention of claim 1. Therefore, the Examiner is respectfully requested to withdraw this rejection of claim 1.

5. Conclusion as to Claim 1

Therefore, for any of the above reasons, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw this rejection of claim 1.

Discussion Regarding the Patentability of Claims 2-7

Claims 2-7 also stand rejected as allegedly being obvious over Latimer in view of Bellis. Claims 2-7 depend, either directly or by way of an intermediate claim, from and incorporate all of the limitations of claim 1. Accordingly, for at least the same reasons as those set forth above in connection with claim 1, it is respectfully submitted that claims 2-7 are patentable over the prior art.

Discussion Regarding the Patentability of Claim 8

1. Claim 8

Claim 8 recites:

A self checkout comprising:
a scanner operative to scan an item;
an electronic article surveillance detector operative to detect whether a successfully scanned item has an active electronic article surveillance tag; and
an electronic article surveillance deactivator operative to deactivate the active electronic article surveillance tag after determining by the electronic article surveillance detector that a scanned item has the active electronic article surveillance tag

Thus, claim 8 recites a system wherein an EAS deactivator is activated in response to determining that a previously scanned item has an active EAS tag.

2. The Discussion of Claim 1 Applies

The Examiner rejected claim 8 based upon the same prior art and the same proposed motivations discussed above with respect to claim 1. (Office action at page 6). Therefore, for the same reasons set forth above with respect to claim 1, there is no motivation for the proposed modification of Latimer. Accordingly, the Examiner has failed to provide a *prima facie* case of obviousness and the Examiner is respectfully requested to withdraw this rejection of claim 8.

3. The Scanner of Latimer is Not A Deactivator/EAS Detector

Moreover, the Examiner relied upon Latimer for disclosing an EAS deactivator that is activated in response to determining that a previously scanned item has an active EAS tag. (Office action at pages 5-6). Respectfully, the Examiner has mischaracterized Latimer.

The precise passage of Latimer relied upon by the Examiner is not clear. The Examiner appears to rely upon Latimer at column 3, lines 14-25 for disclosing the recited type of deactivator. (Office Action at page 5). At the cited passage, Latimer does disclose the activation of an EAS deactivator. The deactivator of Latimer, as noted by the Examiner, is “triggered by a ‘good read’ signal from the scanner 40.” (Latimer at column 3, lines 23-25). As set forth at column 2, lines 63-66 of Latimer, the scanner “projects a scan pattern comprising one or more scan lines out through the windows 44,

46 for reading barcodes.” Thus, a “good read” from the scanner is nothing more than correctly identifying the barcode data on an item. Reading a barcode is not “determining by the electronic article surveillance detector that a scanned item has the active electronic article surveillance tag.”

Alternatively, the Examiner may have been relying upon the disclosure at column 4, lines 26 *et seq* for disclosing the claimed deactivator. (Office Action at page 6). At column 4, lines 26-29, Latimer discusses a deactivation system that includes an antenna to detect EAS tags. There is no indication, however, that a deactivator device is activated in any way in response to determining the presence of an active EAS tag. Rather, the detection of the presence of an active tag is saved as data for use in the training analysis.

Therefore, Latimer fails to disclose an EAS deactivator that is activated in response to determining that a previously scanned item has an active EAS tag. Accordingly, even if Latimer is modified as suggested by the Examiner, the modification fails to arrive at the invention of claim 8. Accordingly, the Examiner is respectfully requested to withdraw this rejection of claim 8.

Discussion Regarding the Patentability of Claims 9-12

Claims 9-12 also stand rejected as allegedly being obvious over Latimer in view of Bellis. Claims 9-12 depend, either directly or by way of an intermediate claim, from and incorporate all of the limitations of claim 8. Accordingly, for at least the same reasons as those set forth above in connection with claim 8, it is respectfully submitted that claims 9-12 are patentable over the prior art.

Discussion Regarding the Patentability of Claim 15

Claim 15 also stands rejected as allegedly being obvious over Latimer in view of Bellis. Claim 15 is an independent claim that includes a processor programmed to “allow deactivation of the active electronic article surveillance tag after determining that the item includes an electronic article surveillance tag.” This is similar to the limitation discussed above with respect to the deactivator of claim 8. Accordingly, for at least the same reasons as those set forth above in connection with claim 8, it is respectfully submitted that claim 15 is patentable over the prior art.

Discussion Regarding the Patentability of Claims 16-19

Claims 16-19 also stand rejected as allegedly being obvious over Latimer in view of Bellis. Claims 16-19 depend, either directly or by way of an intermediate claim, from and incorporate all of the limitations of claim 15. Accordingly, for at least the same reasons as those set forth above in connection with claim 15, it is respectfully submitted that claims 16-19 are patentable over the prior art.

Discussion Regarding the Patentability of Claims 13-14 and 20

Claims 13-14 and 20 stand rejected as allegedly being obvious over Latimer in view of Bellis with further reference to Garber. The Examiner has relied upon Garber solely for the limitations introduced by claims 13, 14 and 20. Even assuming that Garber discloses the limitations alleged by the Examiner and that motivation exists to modify either Latimer or Bellis with Garber, any such disclosure of Garber does not correct the deficiencies of the rejections of claims 8 and 15 as discussed above. Claims 13-14 and

20 depend, either directly or by way of an intermediate claim, from and incorporate all of the limitations of either claim 8 or claim 15. Accordingly, for at least the same reasons as those set forth above in connection with either claim 8 or claim 15, it is respectfully submitted that claims 13-14 and 20 are patentable over the prior art.

IV. Request for Clarification

Finally, the Applicants have attempted herein to fully respond to the Office Action. In the event submission of the present amendment is inappropriate, the Applicants respectfully request the Examiner to identify the section of the MPEP that forms the basis of the Examiner's actions so that the Applicants can determine the appropriate response.

Specifically, after the BPAI reversed the Examiner's rejection of the Applicants' claims, the Examiner appears to have conducted a number of searches over a two day period in an attempt to identify some prior art upon which to base a further rejection. (See Exhibit I, Search History obtained from the PTO website). MPEP 1214.04 specifically states, however, that "[t]he examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references."

MPEP 1214 further states:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

Assuming that the Examiner did not conduct the searches on his private time using his private resources, the two day search conducted by the Examiner shows that the Examiner did not have the required “specific knowledge.” Moreover, the Office Action is bereft of any indicia of authorization from the TC Director for re-opening prosecution.

Additionally, the Examiner has apparently determined that the BPAI is wrong as to the teaching of Bellis since the Examiner now rejects the independent claims (claims 1, 4 and 8) based solely upon Bellis. (Office Action at page 3). In such a circumstance, MPEP 1214 states that “[t]he examiner may request rehearing of the Board decision.” The Applicants are not aware, however, of any proper basis, legal or otherwise, for an examiner at the PTO to overturn a decision of the BPAI *sua sponte* as appears to have occurred in the Office Action.

Therefore, because the Examiner’s actions in issuing the Office Action appear to be contrary to actions authorized by the MPEP and do not appear to have any legal basis, the proper response by the Applicants does not appear to be specifically addressed in the MPEP or legal authority. Accordingly, in the event the Examiner maintains the rejection of the present claims, the Applicants respectfully request that he clarify the authority under which the Office Action has been issued.

V. Claims 21-27.

Claims 21-27 have been added. These claims recite novel and non-obvious limitations. Accordingly, claims 21-27 are believed to be allowable over the prior art.

VI. Conclusion

Applicants respectfully request entry of the amendments and favorable consideration of the application.

A prompt and favorable action on the merits is requested.

Respectfully submitted,
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